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ATTORNEY DOCKET NO. 01153.0001U2
APPLICATION NO. 09/776,412

REMARKS

Claims 17-40 of the present application, U.S. Patent Application No. 09/776,412 ("Application") stand rejected under 35 U.S.C. 102(e) as anticipated by U.S.P.N. 6,341,353 to Herman et al ("Herman"). Claims 17-40 have been canceled and claims 41-61 have been newly added by amendment. No new matter has been added. In view of Remarks, the Applicant respectfully asserts that claims 41-61 are allowable.

Rejections Under 35 U.S.C. §102(e)

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). For a process, anticipation requires identity of the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988). Those elements must also be arranged as in the claim. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). For anticipation, there must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Independent Claim 41

Claim 41 has been newly added by amendment, and incorporates subject matter from canceled claims 17 and 18. Accordingly, rejections regarding claims 17 and 18 will be discussed with respect to claim 41.

Claim 41 provides a method for providing electronic receipts using an electronic receipt generator, and recites in part:

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A method for providing electronic receipts using an electronic receipt generator, comprising the steps of:

...

c. generating by the electronic receipt generator an electronic receipt comprising detailed information describing the sales transaction, wherein the detailed information comprises sale price, total transaction amount, item description, information indicating completion of the sales transaction, and a hyperlink associated with a product return procedure;

...

f. activating, by the buyer, the hyperlink on the computing device;

g. transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning the product;

h. displaying the return information on the computing device;
(Emphasis added).

As seen above, claim 41 recites generating an electronic receipt that includes a hyperlink associated with a product return procedure, activating the hyperlink by the buyer, and transmitting, in response to activation of the hyperlink, return information containing steps for returning the product.

On page 4 of the Office Action, it is asserted that Herman discloses:

b. generating by the electronic receipt generator an electronic receipt including detailed information describing the sales transaction, wherein the detailed information includes sale price, total transaction amount, item description (fig. 22), information indicating completion of the transaction (col. 1, lines 63-66), and a hyperlink associated with a product return procedure (col. 2, lines 11-14);

...

f. transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning the product (col. 43, line 4 to col. 44, line 37; figs. 16-17 and 19);

The Applicant respectfully disagrees with the above-characterization of Herman and asserts that claim 41, when properly considered as a whole, is not anticipated by Herman for at

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least the reason that Herman does not disclose generating an electronic receipt that includes a hyperlink associated with a product return procedure, activating the hyperlink by the buyer, and transmitting, in response to activation of the hyperlink, return information containing steps for returning the product, as recited in claim 41.

Herman at Col. 2, lines 9-17 discloses:

The Smart Receipt provides the customer with detailed information about an online purchase in a standardized format. Hyperlinks embedded in the Smart Receipt enable the customer to access customer service and order status. The merchant may also embed additional services within the Smart Receipt, including special offers for future purchases. Offers provided in a Smart Receipt can be personalized to a user's preferences which are stored on the Trusted Agent Server. (Emphasis added).

Herman at Figure 22 discloses:

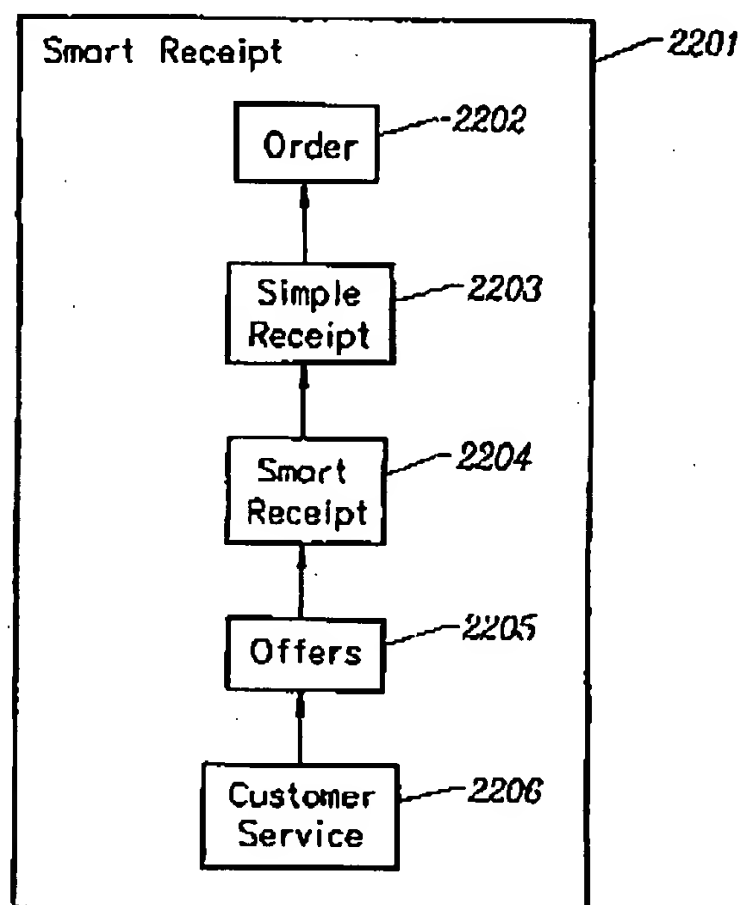


FIG. 22

Herman at Col. 44, line 64 to Col. 45, line 16 discloses:

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The interaction with the buyer that is gained from Smart Receipts allows the merchant to provide good customer service; customers are more assured that they will receive prompt, reliable service. It simplifies user record keeping and gives the manufacturer another route to notify customers of product updates.

Post-Purchase Services

The Smart Receipt enables the merchant to provide post-purchase services to the customer by embedding additional information within the XML representation of the receipt. Each of these embedded components may be URLs or they may be LEDOs that represent:

Offers (see Offers section)

Warranties

Extended Warranties (an offer than sells a warranty)

Customer Service request--web form that contains frequent problems and assists in routing an email message to the correct department (Emphasis added).

As seen above, Herman does refer to "customer service." Theses references, however, do not anticipate claim 41. For example, Herman's generic references to "customer service", such as in Figure 22, do not teach or disclose transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning the product. Nor does Herman's web form that contains frequent problems and that assists in routing an email message to the correct department disclose transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning the product. The Applicant has searched Herman and respectfully asserts that it nowhere discloses transmitting, to the computing device and in response to activation of the hyperlink, return information containing steps for returning the product. Accordingly, claim 41, when properly considered as a whole, is allowable for at least the reason that Herman does not disclose generating an electronic receipt that includes a hyperlink associated with a product return procedure, activating the

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hyperlink by the buyer, and transmitting, in response to activation of the hyperlink, return information containing steps for returning the product, as recited in claim 41.

Claim 41 also recites subject matter from canceled claim 18. Specifically, claim 41 recites in part:

- i. requesting, by the buyer, a return shipping label for the product;
- j. transmitting the return shipping label to the computing device;
- and
- k. producing a hard copy of the return shipping label using the computing device.

To support a rejection of claim 18, now canceled, the Office Action on page 5 states:

Re claims 18, 20, and 40, Herman teaches a.) requesting, by the user, a return shipping label for the product pursuant to a step for returning the product, b.) transmitting the return shipping label to the computing device, and c.) producing a hard copy of the return shipping label using the computing device (col. 38, lines 8-24). *Herman discloses a returning product includes either through a link to redemption at an online commerce site or by being printed on paper.* (Emphasis in original).

The cited language from Herman discloses:

The direct response server enables the creation, delivery, and single-click redemption of direct response offers from anywhere on the Internet. These offers can be delivered to trusted agents according to consumer preferences, or found in a banner-like format on Web sites. The direct response server can deliver online any one of at least three classic forms of traditional direct response. First, they can handle a direct order by concluding a transaction for the product they represent without requiring a jump to any other site.

Second, they can generate a lead by transmitting a request to a merchant for additional information.

Third, they can generate store traffic, either through a link to redemption at an online commerce site, or by being printed on paper and taken for redemption to an actual retailer location. (Emphasis added).

As asserted on pages 11-12 of the Office Action Response mailed February 27, 2006, Herman does not disclose requesting, transmitting, and producing a hard copy of a return shipping label. Rather, Herman discloses the redemption of special offers based on consumer

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preferences delivered via a banner on a web site. The redemption of special offers via a web site banner clearly does not disclose requesting, transmitting, and printing a return shipping label as recited in claim 41. The above-cited language also discloses printing redemption offers and taking them to a retail location. Printing redemption offers clearly does not disclose requesting, transmitting, and producing a hard copy of a return shipping label as recited in claim 41. The Applicant would like to emphasize that a "direct response offer" that can be "printed on paper and taken for redemption to an actual retailer location" does not disclose requesting, transmitting, and producing a copy of a return shipping label. Thus, the Applicant respectfully asserts that claim 41 is allowable for at least the reason that Herman does not disclose requesting, transmitting, and producing a hard copy of a return shipping label as recited in claim 41.

Dependent Claims 42-46

Claim 42 recites subject matter from canceled claim 34, reciting wherein the first network comprises a wireless network operating at a location associated with the first seller.

To support a rejection of claim 34, now canceled, the Office Action states on page 6 that:

Re claim 34, Herman teaches second network is a wireless network operating at the location associated with the seller (col. 4, lines 7-26). Herman discloses a general Internet service provider. (Emphasis in original).

The cited language discloses:

The application service provider may be a general Internet service provider (e.g., AOL, CompuServe, Pacific Bell), a game specific service provider (e.g., Mpath, Heat, TEN), an open network market-specific service, a closed or private network service, or any other service provided over a computer network. For illustrative purposes only, the below discussion emphasizes the example of a Transactor system in which the application service provider comprises a game server, and the end-users comprise game clients.

End users 30 interact with one another and with game server 50 over a computer network (e.g., the Internet) 60 in a virtual world (e.g., an interactive environment governed by a prescribed set of rules) provided by game server 50 and supported by Transactor server 20. In this virtual world, digital property can be owned by,

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used, and transferred among end users. End users can also transfer digital property while offline (i.e., not in communication with the game or Transactor servers). Transactor server 20 communicates with Transactor broker 40 over the Internet 60 or, optionally, by a direct communications link. (Emphasis added).

The above-cited language discloses a general Internet service provider and end users interacting with one another and with a game server over a computer network in a virtual world. The Applicant respectfully asserts that the cited language plainly does not disclose the method of claim 41 wherein the first network comprises a wireless network operating at a location associated with the first seller. Accordingly, claim 42 is allowable over Herman. Claim 42 is also allowable for at least the reason that it depends from allowable claim 41.

Claims 43-46 each depend directly or indirectly from claim 42, and so are each allowable for at least the reasons given for the allowability of claim 42.

Dependent Claims 47-54

Claim 47 depends from claim 41, and is allowable for at least the reason that Herman does not disclose the method of claim 41 further comprising generating by the electronic receipt generator information from a plurality of electronic receipts that are associated with the buyer and that are associated with a plurality of sellers; converting by the electronic receipt generator the information generated from the plurality of electronic receipts to a determined format; and transmitting the converted information generated from the plurality of electronic receipts to the buyer over the second network. Claim 48 depends from claim 46, and is allowable for at least the reasons given for the allowability of claims 46 and 47.

Claim 49 depends from claim 41, and is allowable for at least the reason that Herman does not disclose the method of claim 41 further comprising generating by the electronic receipt generator information from a plurality of electronic receipts that are associated with the buyer and that are associated with a plurality of sellers; and using the information generated from the plurality of electronic receipts by a third party to perform market research. Claim 50 depends from claim 48, and is allowable for at least the reasons given for the allowability of claims 48 and 49.

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Claim 51 depends from claim 41, and is allowable for at least the reason that Herman does not disclose the method of claim 41 further comprising generating by the electronic receipt generator information from a plurality of electronic receipts that are associated with a plurality of buyers and that are associated with at least the first seller; and transmitting the information generated from the plurality of electronic receipts to the first seller. Claim 52 depends from claim 50, and is allowable for at least the reasons given for the allowability of claims 50 and 51.

Claim 53 depends from claim 41, and is allowable for at least the reason that Herman does not disclose generating by the electronic receipt generator information from a plurality of electronic receipts that are associated with a plurality of buyers and that are associated with at least the first seller; and using the information generated from the plurality of electronic receipts by the first seller to perform market research. Claim 54 depends from claim 52, and is allowable for at least the reasons given for the allowability of claims 52 and 53.

Independent Claim 55

Claim 55, like claim 41, is allowable for at least the reason that Herman does not disclose requesting, transmitting, and producing a hard copy of a return shipping label.

Claim 55 is also allowable for at least the reason that Herman does not disclose conducting a first plurality of sales transactions between a buyer and a plurality of sellers; transmitting information about each of the first plurality of sales transactions to the electronic receipt generator; generating by the electronic receipt generator information from the first plurality of sales transactions; conducting, after the first plurality of sales transactions between the buyer and the plurality of sellers, a first sales transaction between the buyer and a first seller involving a first product; transmitting information about the first sales transaction to the electronic receipt generator; and using the information generated from the plurality of sales transactions to determine an accessory of the first product, as recited in claim 55.

Claim 55 is further allowable for at least the reason that Herman does not disclose generating by the electronic receipt generator a first electronic receipt for the first sales transaction, wherein the first electronic receipt comprises detailed information describing the first sales transaction, a hyperlink associated with a product return procedure for the first product, and a hyperlink

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associated with the determined accessory of the first product; transmitting the first electronic receipt to a computing device associated with the buyer; activating, by the buyer using the computing device, the hyperlink associated with the determined accessory of the first product; and displaying on the computing device information about the determined accessory of the first product, as recited in claim 55.

Dependent Claims 56-58

Claims 56-58 are allowable for at least the reason that each depends directly or indirectly from allowable claim 55.

Independent Claim 59

Claim 59 is allowable for at least the reason that Herman does not disclose generating by the electronic receipt generator information from the first plurality of electronic receipts that describes the first plurality of sales transactions but that does not personally identify any individual buyer; transmitting the information generated from the first plurality of electronic receipts to a third party; and performing market analysis by the third party using the information generated from the first plurality of electronic receipts, as recited in claim 59.

Dependent Claims 60 and 61

Claims 60 and 61 are allowable for at least the reason that each depends directly or indirectly from allowable claim 59.

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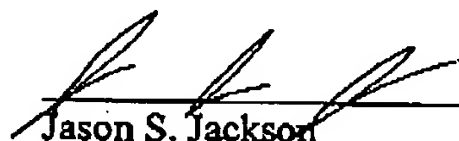
ATTORNEY DOCKET NO. 01153.0001U2
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In view of the above, each of the presently pending claims in the Application is believed to be in immediate condition for allowance. A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$1,475.00, representing \$395.00 for the Request for Continued Examination (RCE) Fee under 37 C.F.R. § 1.17(e), and \$1,080.00 for the Five-Month Request for Extension of Time under 37 C.F.R. § 1.17(a)(5) for a small entity, is also enclosed.

This fee is believed to be correct, however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.


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I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via facsimile transmission to Mail Stop RCE, Commissioner for Patents at (571) 273-8300, on the date indicated below.


Jason S. Jackson6-20-2007
Date